IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:		)
	Whitten et al.	)
Serial No:	09/802,797	) Appeal No.
Confirmation No:	8294	)
Filed:	3/09/2001	)
For:	Method and Apparatus for Managaing Data in a Gaming System	)
Examiner	Dat Nguyen	)

The Honorable Commissioner of Patents
Mail Stop Appeal Brief - Patents
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BRIEF OF APPELLANT

        The Applicant has filed a timely Notice of Appeal from the action of the

Examiner in finally rejecting all of the claims that were considered in this

application. This Brief is being filed under the provisions of 37 C.F.R. §1.192. The

Filing Fee, as set forth in 37 C.F.R. §1.17(c), is submitted herewith.

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REAL PARTY IN INTEREST

The real party in interest is Microsoft Corporation, by way of assignment from Whitten et al., who is the named inventive entity and is captioned in the present brief.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Allowed Claims: No claims have been allowed

Canceled Claims: Claims 1-17, 19, 36-56, 59 and 61-68 were previously canceled.

Pending Claims: Claims 18, 20-35, 57-58, 60 and 69-71 are pending in the application and stand finally rejected by the Examiner

Appealed claims: All of the pending claims are subject to this appeal.

STATUS OF AMENDMENTS

A Non-Final Office Action rejecting pending claims 18, 20-35, 57-58, 60 and 69-71 under 35 U.S.C. §103 was issued November 16, 2005.

A Response to the Non-Final Office Action was filed on February 16, 2006. No claims were amended in this Response.

A Final Office Action was issued November 13, 2006 finally rejecting pending claims 18, 20-35, 57-58, 60 and 69-71 under 35 U.S.C. §103.

A Request for a Pre-Appeal Review and A Notice of Appeal were timely filed on January 30, 2007 in response to the Final Office Action.

A Notice of Decision from Pre-Appeal Brief Review was issued on March 16th, 2007 maintaining the rejections.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Following is a brief summary of independent claims 18, 22, 27, 57, and 69 with exemplary references to the drawings and disclosure inserted for convenience. References should not be understood as limiting any feature to the recited portions of the disclosure.

Claim 18 recites a game console (102) comprising a processor (200) and a hard disk drive (208) coupled to the processor, wherein the hard disk drive stores a console application (410) to which the game console boots, and wherein the hard disk drive is configured to store application data (406) such that data associated with a first application is inaccessible to other applications. (*Summary; FIG. 2; FIG. 5; p. 17, lines 8-19*).

Claim 22 recites a video game system (100), comprising: a processor (200); and a hard disk drive (208) coupled to the processor, the hard disk drive having: a first region (404) to store user data that includes game data (502-508) saved by a user of the video game system when the processor executes a video game; and a second region (406) to store application data (510-516) that includes data specific to the video game executed by the processor, wherein user data associated with the video game is segregated from user data associated with other video game applications and wherein the application data associated with the video game is segregated from application data associated with other video game applications. (*FIG. 5; p.17, lines 8-19*).

Claim 27 recites a method comprising: identifying a game identifier associated with a video game installed in a game console (704), wherein the game console contains a hard disk drive (208); determining portions of the hard disk drive that are associated with the video game based on the game identifier; (706) and preventing the video game from accessing portions of the hard disk drive that are not associated with the video game. (*FIG. 7; p.21 line 5- p.22 line 3.)*

Claim 57 recites a computer-readable medium for a game console (102) comprising computer-executable instructions that, when executed, direct the game console to: associate user data (502) with a first region (404) of a hard disk drive (208) contained in the game console; associate video game application data (510) with a second region (406) of the hard disk drive; allow a video game application to access particular portions of the first region that are associated with the video game application; allow the video game application to access particular portions of the second region that are associated with the video game application; and prevent the video game application from accessing portions of the first region and the second region that are associated with other applications. *(FIG.5; p.17, lines 1-19).*

Claim 69 recites a game console (102) comprising: an input port (240) for receiving input from a controller (104) operable by a player to generate video game control signals; an output port (228) for outputting a display of three-dimensional video game play graphics for a television; a processor (200) for executing instructions of a video game program; a controller system coupled to said input port and to said processor for executing commands related to the video

game control signals; a portable media reader (106) for optically reading media to be executed by the processor so as to output to the output port a display of graphics in accordance with the media; and a fixed disk in a non-removable hard disk drive (208) in communication with the processor, the fixed disk including a boot sector for storing boot instructions to boot the processor to load an initial program, wherein: upon booting the processor to load the initial program, the execution of the initial program by the processor outputs to the output port a display of a user interface that provides a prompt for selecting media to execute on the game console (260; FIG. 9), wherein the processor will not boot without initially loading the initial program read from the fixed disk; and processor executes instructions that are read from the selected media by the portable media reader. *(FIG. 2, p. 3 lines 8-12; p.10 lines 4-12).*

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.	Claims 18, 20-25, 27-35, 57, 58, 60 and 69-71 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,599,194 to Smith et al. ("Smith") in view of Microsoft®Windows98.

2.	Claims 26, 32, and 33 stand rejected under 35 U.S.C. §103(a) over Smith in view of Microsoft®Windows98 in further view of Links 386CD Players Manual.

<center>**ARGUMENT**</center>

1.   **FIRST GROUND OF REJECTION**

The Examiner in rejecting 18, 20-25, 27-35, 57, 58, 60, and 69-71 argues these claims are obvious under 35 U.S.C. §103(a) over Smith in view of Microsoft®Windows98 (pp. 80-81 and 87-90 cited by the Examiner). The Applicant respectfully disagrees. For at least the reasons that follow it is respectfully requested that the §103(a) rejection be overturned.

    a. Brief Discussion of the Application and References

The present Application describes a gaming system in which a hard drive is used to store various data. The gaming system uses a storage hierarchy with the hard disk drive to prevent unauthorized access to data stored on the hard disk drive. For example, each application (e.g., videogame) may have a unique identifier and be provided with a separate area for storing related data. Using the unique identifier and storage hierarchy of the hard disk, data related to a particular application is made accessible to the particular application, but may be inaccessible to other applications. (*Summary; p. 1, lines 8-19).*

Smith is directed to modifications for an existing gaming system. Thus, a known gaming system may be modified to couple the gaming system to the Internet and to include a mass storage device. The modification may be by way of an expansion device coupled to a video game system port. *Smith, Abstract.* While modifications to existing gaming systems are described, Smith lacks disclosure

related to a gaming system with a hard disk drive having a storage hierarchy to prevent unauthorized access to data stored on the hard disk drive.

Microsoft®Windows98, in the portions relied upon (*pp. 80-81 and 87-90*), describes a FAT32 file system and network sharing of folders and printers through access control. Users and groups may be specified for sharing of folders in a network environment. While a file system and network sharing of folders/printers is described, the asserted portions of Microsoft®Windows98 lack the inaccessibility feature of Applicant's claims as presently recited. For instance, the asserted portions lack discussion of storing game data such that data related to a particular application is made accessible to the particular application, but is inaccessible to other applications.

b. Overview

In making out the rejections, the Office correctly acknowledges that Smith fails to teach a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. The Office argues that Microsoft®Windows98 teaches these features. The portion of the rejection addressing the combination of Smith and Microsoft®Windows98 from the Office Action dated 11/16/2005, p.7 is excerpted below for convenience:

Although Smith et al. does not appear to explicitly disclose a hard disk drive having a user data region and an application region; a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications; and preventing the video game from accessing portions of the hard disk drive that are not associated with the video game Microsoft®Windows98 teaches these features.

It would have been obvious at the time of applicant's invention to utilize the advance file management techniques taught in Microsoft®Windows98 in order to partition a hard disk drive into separate application regions and to make certain files inaccessible to other applications in the video game. One would be motivated to do such that game data from different video games would be placed in a particular location on a hard drive such that game data and application data would be stored on the hard disk drive in an organized manner (pp. 80-81 and 87-90).

Applicant appreciates and agrees with the Examiner's acknowledgement in the above excerpted portion that Smith does not disclose "a hard disk having a data region and an application region, a game console having a hard disk that is configured to store application data such that data associated with a first application is inaccessible to other applications; and preventing the video game from accessing portions of the hard disk drive that are not associated with the video game". However, Applicant asserts that Microsoft®Windows98 fails to correct these acknowledged defects in Smith. Smith and Microsoft®Windows98, alone or in combination, fail to disclose, teach, or suggest the features of Applicant's claims. Applicant maintains that a *prima facie* case of obviousness has not been established at least because (1) the proposed combination lacks all the recited features of the Applicant's claims (2) the combination is impermissibly based on

hindsight; and (3) motivation to support the proposed combination is lacking. A detailed discussion of each of these arguments is provided respectively in points d, e, and f below. For brevity, the arguments are first made with respect to claim 18 and then referenced as applicable to the remaining claims. For at least these reasons, Applicant respectfully requests that the Board overturn the First Ground of Rejection.

c. 35 U.S.C. §103 Standard

Initially, a discussion of the requirements for a proper rejection under 35 U.S.C. §103 is provided for convenience.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §2142.* The Federal Circuit has stated that when one or more reference or source of prior art is required in establishing obviousness, "it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitutions or other modification." *In re Fine, 5 USPQ 2d, 1596, 1598 (Fed. Cir. 1988).* That is, to make out a *prima facie* case of obviousness, the

references must be examined to ascertain whether the combined teachings render the claimed subject matter obvious. *In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979).*

Moreover, there is a requirement that there must be some reason, suggestion, or motivation from the prior art, as a whole, for the person of ordinary skill to have combined or modified the references. *See, In re Geiger, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).* It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious as the following excerpt makes clear.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. …. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)* quoting *In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).*

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference is said to teach away when a person or ordinary skill, upon reading the

reference, would be led in a direction divergent from the path that the applicant took. *In re Gurley, 31 USPQ 2d 1130, 1131 (Fed. Cir 1994).*

In addition to the standard discussed above, the Office has provided a paper, available at the following link:

http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm

The paper available at this link describes proper and improper rejections made under §103(a). Particularly instructive is Example 17 that appears in Section V of the paper illustrating an improper §103(a) rejection which is based upon a proposed motivation that is simply too general and lacking in particularity. This example is reproduced below in its entirety for the Office's convenience:

V. Examples of Improper Rejection under 35 U.S.C. 103

Example 17: Improper rejection based upon hindsight - general motivation statement.

a. The claimed invention

The invention is drawn to a smart card containing a tracking mechanism, which tracks shopping preferences of consumers by recording the type, quantity, and dates of purchase for a pre-selected group of products. The smart card is useful in a system and method for introducing new and alternative products that are of the same type as products normally purchased by the shopper. The smart card records the shopper's purchases and submits an automatic notification to the shopper when a quantity threshold is achieved for the pre-selected products. This notification will encourage the consumer to consider alternative products by providing the consumer incentives, such as a pricing discount, to purchase an alternative product.

Claim 1:

A method for using a smart card in a marketing analysis program designed to introduce new products, the method comprising the steps of:

storing product information on the smart card when said products are purchased by a consumer wherein said information including type, quantity and dates of the product purchased;

identifying for each product a threshold for each of said type, quantity and dates of products purchased;

determining an incentive for an alternative product based on said threshold; and

automatically notifying said consumer when said threshold is reached for a given product identified on the smart card and providing the consumer with said incentive, whereby the incentive encourages the consumer to consider alternative products.

b. Evidence

Reference A discloses smart card that tracks consumer preferences by recording the type, quantity, and dates of purchase of pre-selected products to determine trends in consumer purchases. The smart card is periodically read by a scanner to determine its contents for market analysis. In return for using the smart card and participating in the marketing program, the user is provided with free product coupons for products that are normally purchased by the shopper.

Reference B discloses a traditional consumer incentive program that provides coupons for the purchase of named products based upon the consumer's purchase of those same products to promote customer loyalty.

c. Poor statement of the rejection

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Reference A in view of Reference B. Reference A discloses the conventional use of a smart card to track

consumer preferences and provide incentives. However, Reference A does not disclose the automatic notification to consumer providing incentives. Reference B discloses providing incentives to consumers to purchase the desired products. *It would have been obvious to combine Reference A's smart card with Reference B's incentive to consumers because the combination would allow Reference A's smart card to be more efficient.*

d. Analysis

The motivation, improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A and does not address why this specific proposed modification would have been obvious. Additionally, there is nothing in either of references that would suggest automatically notifying the consumer when reaching a threshold nor is there anything in either reference that would suggest the notifying step. Finally, although Reference B teaches a traditional coupon scheme to promote customer loyalty, there is no suggestion, other than applicant's disclosure, to employ this scheme to promote the introduction of new and alternative products. **The rejection is improper.**

d. The proposed combination of Smith and Microsoft®Windows98 lacks all the recited features of the Applicant's claims.

It is respectfully requested that the First Ground of Rejection be overturned at least because the proposed combination fails to disclose, teach, or suggest all the claimed features as required for a proper rejection under 35 U.S.C. §103. For example:

Claim 18 recites a game console comprising
- a processor and
- a hard disk drive coupled to the processor,
- wherein the hard disk drive stores a console application to which the game console boots, and
- wherein the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other applications.

In making out the rejection of this claim, the Office acknowledges that Smith fails to teach a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. The Office, per the previous excerpt, asserts Microsoft® Windows98 for these features of claim 18. The Office argues that it would have been obvious at the time of Applicant's invention to utilize the advance file management techniques taught by Microsoft® Windows98 "in order to partition a hard disk drive into separate application regions and to make certain files inaccessible to other applications in the video game." Even if the file system of Microsoft® Windows98 were to be combined with the gaming system modifications described in Smith, the combination still fails produce the features of claim 18. In particular, the recited inaccessibility feature of claim 18, "wherein the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other applications", is not provided via the proposed combination.

As noted in the discussion of the §103 standard, a *prima facie* case of obviousness requires that the combination of references disclose, teach, or suggest

all the claimed features. In this case, Microsoft® Windows98 does not teach, or in any way suggest, a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications. The Office has acknowledged that Smith lacks these claimed aspects. As such the combination of Smith and Microsoft® Windows98 fails to disclose, teach, or suggest the claimed subject matter.

The first part of the excerpt cited by the Office from Microsoft®Windows98 (p.80-81) discusses the difference between the FAT16 and the FAT32 file systems. While this discussion does deal with ways in which a hard drive can be organized, there is no mention whatsoever of the ability for the hard disk drive to be configured to store application data such that data associated with a first application is inaccessible to other applications as is recited in claim 18. It is noted that no particular explanation of the applicability of this portion of Microsoft®Windows98 is provided by the Office.

The second part of the excerpt from Microsoft®Windows98 cited by the Office (p. 87-90) deals with the sharing of folders and printers attached to a user's computer with other people on a network. Again, no particular explanation of this portion is provided by the Office, rather the Office generally asserts that Microsoft®Windows98 provides the features which are acknowledged as lacking in Smith. Applicant presumes that the Office is trying to show that because Microsoft® Windows98 teaches that a user can specify that a folder or printer cannot be accessed by other users on a network, that in some way this teaches data

associated with a first application is inaccessible to other applications. However, the Applicant disagrees and submits that the second part of the excerpt cited by the Office fails to teach or suggest a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications as recited in claim 18. The aforementioned portions of Microsoft® Windows98 are entirely devoid of discussion regarding application data, applications accessing data, or data associated with a first application is inaccessible to other applications. Sharing of files and folders in a network with share level control settings is not equivalent to the recited features of claim 18. Accordingly, for at least the reasons discussed above, the Office has failed to make out a *prima facie* case of obviousness. As such, claim 18 is allowable.

e. The proposed combination of Smith and Microsoft® Windows98 is impermissibly based on hindsight.

Assuming, for the sake of argument only, that the combination of Smith and Microsoft®Windows98 is somehow construed as providing the features required by claim 18 as presently recited, the Applicant submits that the proposed combination of Smith and Microsoft®Windows98 is impermissibly based on hindsight. Thus, the §103 rejection is improper and it is respectfully requested that the First Ground of Rejection be overturned for at least this reason.

As discussed above, there is a requirement that there must be some **reason, suggestion, or motivation** from the prior art, as a whole, for the person of

ordinary skill to have combined or modified the references. *See, In re Geiger, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).* It is impermissible to use the claimed invention as an **instruction manual or "template" to piece together the teachings of the prior art** so that the claimed invention is rendered obvious. **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.** *In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).*

Here, the Office has used hindsight reconstruction by using the claimed subject matter as a template to piece together Smith and Microsoft®Windows98. Smith deals exclusively with the modification of an existing video game system whereas Microsoft®Windows98 deals with the sharing of folders and printers by a user with other people on a network. As such, these two references appear to be completely unrelated. It appears that the Office has chosen to combine Smith with Microsoft®Windows98 merely because Microsoft®Windows98 contemplates giving a user the choice to make folders and printers accessible or inaccessible to other users on a network. Without the Applicant's disclosure as an instruction manual, there is no way that one with ordinary skill in the art would look to the excerpt cited by the Office from Microsoft®Windows98 in order to design a hard drive for a video game system. Further, applying network file and printer techniques of Microsoft®Windows98 to video game data, might arguably produce a game system with network file and printer sharing, but does not without more produce the claimed features, such as "wherein the hard disk drive is configured to

store application data such that data associated with a first application is inaccessible to other applications". In the absence of reliance upon the Applicant's own disclosure, there simply is no convincing reason why one of skill in the art would have select particular features from Smith and Microsoft®Windows98 and combined those features in the manner claimed. In fact, Applicant respectfully submits that given the failure of the Microsoft®Windows98 reference to supply the missing features, even had one of ordinary skill consulted this reference, it would not lead to the subject matter of this claim. For this additional reason, the Office has failed to make out a *prima facie* case of obviousness.

f. <u>Sufficient motivation to support the proposed combination of Smith and Microsoft® Windows98 is lacking.</u>

It is further requested that the First Ground of Rejection be overturned at least because the sufficient motivation to combine the references is lacking.

The Office reasons that the motivation to support the propose for this combination would be to place game data from different video games in a particular location on a hard drive such that game data and application data would be stored on the hard disk in an organized manner (citing to pages 80-81 and 87-90). Applicant respectfully disagrees with the Office and submits that the Office has failed to make out a *prima facie* case of obviousness.

The Office argues that the motivation would be to store data in an *organized* manner. To begin with, Smith does not describe a problem in which its data is stored

in an unorganized manner such that it would benefit in any way from Microsoft®Windows98's teachings. Thus, there is no foundation in Smith to support the Office's combination. The Office acknowledges that Smith does not have any such problem. *See, Office Action dated 11/13/06, p. 4, para. 8*. If Smith does not have any such problem, as the Office admits, why would one look to Microsoft®Windows98 to solve a non-existent problem? The Office argues that the motivation to combine these references is not too general because the problem is a general problem. *See, Office Action dated 11/13/06, 2006, p. 4, para. 7*. The Office further states that "[o]ne is faced with …the problem of restricting access to certain files or folders from unauthorized programs and games and so limiting access would make the hard disk more organized and prevent alteration of files from unauthorized program." *See, Office Action dated 11/13/06, p.4, para. 7*. Again, Smith does not discuss any problem associated with unauthorized access by applications to data.

The Office's stated motivation (e.g., to store application data in an organized manner) is akin to arguing that the combination would make for a more efficient solution. As discussed above, however, **the motivation, to improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A** and does not address why this specific proposed modification would have been obvious. Similarly here, the Office has suggested that one would be motivated to combine Smith with Microsoft®Windows98 so that game data and application data would be stored on the hard disk in an **organized matter**. Respectfully, the motivation to improve the organization of a

hard disk is too general because it could cover almost any alteration contemplated and it does not explain why one of ordinary skill in the art would choose the required features and combine them in the manner claimed.

For instance, "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or **the examiner must present a convincing line of reasoning** as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp, 227 USPQ 972, 973 (Bd.Pat. App. & Inter. 1985)(emphasis added).* In making out a §103 obviousness rejection, there is a particular emphasis on specificity. "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" *In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).*

Thus, even if all the features are described by the proposed combination (which they are not), the Examiner has failed to provide a convincing line of reasoning explaining why the skilled artisan, with no knowledge of the Applicant's disclosure, would have selected the required components for combination in the manner claimed.

For the sake of argument only, Applicant now assumes that the file system of Microsoft® Windows98 may be combined with Smith. However, merely adding a file system to Smith does not result in a device in which data in the file

system is arranged in the claimed manner. The Examiner makes a logical leap between the file system of Microsoft®Windows98 and the claimed features which is not explained, nor supported by the references of record. The file system of Microsoft®Windows98 presumably could be used to accomplish the asserted motivation of organizing data in various ways. However, the Office fails to provide any reasoning as to why particular components would be selected for combination in the manner claimed in claim 18, such as "wherein the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other applications" as recited in claim 18. The Office simply makes a general allegation that Microsoft®Windows98 discloses the features which Smith undisputedly lacks and does not even particularly discuss components from Microsoft®Windows98 which are relied upon. *See, Office Action dated 11/16/2005, p. 7 (excerpted above).* Accordingly, sufficient motivation to support the proposed combination of Smith and Microsoft®Windows98 is lacking and it is respectfully requested that the First Ground of Rejection be overturned for at least this reason.

For all of the reasons discussed above, the Office has failed to make out a *prima facie* case of obviousness. As such, claim 18 is allowable.

g. Claims 20-25, 27-35, 57, 58, 60, and 69-71 are allowable at least for reasons discussed with respect to claim 18 as well as for their own recited features.

The arguments made with respect to claim 18 are also applicable to 20-25, 27-35, 57, 58, 60, and 69-71. Thus, these claims are allowable based upon similar reasoning, as well as for their own recited features which the references of record fail to disclose, teach, or suggest. For example:

Claims 20-21 depend from claim 18 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 18, are neither disclosed nor suggested in the references cited and applied by the Office.

Claim 22 recites a video game system, comprising:
- a processor; and
- a hard disk drive coupled to the processor, the hard disk drive having:
    - a first region to store user data that includes game data saved by a user of the video game system when the processor executes a video game;
    - and a second region to store application data that includes data specific to the video game executed by the processor, wherein user data associated with the video game is segregated from user data associated with other video game applications and wherein the application data associated with the video game is segregated from application data associated with other video game applications.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98. Applicant respectfully disagrees. Claim 22 is allowable at least for reasons discussed with respect to claim 18 as well as for its own recited features.

For instance, the Smith reference fails to disclose a game console having a hard disk drive that has "a first region to store user data" and "a second region to

store application data" as recited in claim 22. Further, Smith fails to disclose "wherein user data associated with the video game is segregated from user data associated with other video game applications and wherein the application data associated with the video game is segregated from application data associated with other video game applications". Although Smith discloses a hard disk drive, Smith does not disclose a hard disk drive that stores data in the manner recited in this claim.

In rejecting this claim, the Office cites to Fig. 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46 and 54-67, and Column 25, lines 3-22 of Smith. Regarding Fig. 4, the figure shows an expansion device that includes a hard disk drive 206. However, Fig. 4 fails to disclose a user data region and an application region. Regarding Column 1, lines 17-18, the cited text discusses a home video game system that includes a hard disk drive. This cited text lacks any reference to a user data region and an application region. Regarding Column 2, lines 34-38, the cited text discloses "…a mass storage device such as a hard disk drive to permit the downloading of entire games into the mass storage device." This text fails to disclose a hard disk drive having a user data region and an application region.

Regarding Column 3, lines 40-46, the cited text discloses that the described video game system may alternatively be packaged in a common integrated housing and sold as a single unit. This disclosure does not mention the hard disk drive or its contents. Regarding Column 3, lines 54-67, the cited text mentions

that the system may start under control of a program resident on the hard disk drive. The cited text also mentions that the expansion device may include a modem and a hard disk drive, and allows a video game player to surf the World Wide Web. This cited text fails to disclose a hard disk drive having a user data region and an application region.

Regarding Column 25, lines 3-22, the cited text discusses the decryption and execution of games as well as displaying options to the user to execute various application programs. This text does not disclose a hard disk drive having a user data region and an application region. Thus, the portions of Smith relied on by the Office fail to disclose the elements of the claim that the Office argues it does.

Furthermore, as discussed above with regards to claim 18, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98. For all of the reasons discussed above, claim 22 is allowable.

Claims 23-25 depend from claim 22 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 22, are neither disclosed nor suggested in the references cited and applied by the Office.

Claim 27 recites a method comprising:

- identifying a game identifier associated with a video game installed in a game console, wherein the game console contains a hard disk drive;
- determining portions of the hard disk drive that are associated with the video game based on the game identifier; and
- preventing the video game from accessing portions of the hard disk drive that are not associated with the video game.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98. Applicant respectfully disagrees. Claim 27 is allowable at least for reasons discussed with respect to claim 18 as well as for its own recited features.

For instance, the Smith reference fails to disclose "preventing the video game from accessing portions of the hard disk drive that are not associated with the video game" as recited in this claim. Although Smith discloses a hard disk drive accessed by various applications, Smith does not disclose preventing access in the manner recited in this claim.

The Office alleges "[i]nherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game." *Office Action dated 11/16/2005, p.4.* Applicant disagrees with this allegation. Even if this allegation were true, this does not disclose, teach, or suggest *preventing* the video game from accessing portions of the hard disk drive that are not associated with the video game. Inherently not accessing portions of the hard disk drive is different from and not to

be confused with being prevented from doing so. Accordingly, Applicant submits that the Smith reference does not disclose the elements of claim 27.

Furthermore, as discussed above with regards to claim 18, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98. Thus, for at least these reasons, claim 27 is allowable.

Claims 28-35 depend from claim 27 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 27, are neither disclosed nor suggested in the references cited and applied by the Office.

Claim 57 recites a computer-readable medium for a game console comprising computer-executable instructions that, when executed, direct the game console to:

- associate user data with a first region of a hard disk drive contained in the game console;
- associate video game application data with a second region of the hard disk drive;
- allow a video game application to access particular portions of the first region that are associated with the video game application;
- allow the video game application to access particular portions of the second region that are associated with the video game application; and
- prevent the video game application from accessing portions of the first region and the second region that are associated with other applications.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98.   Applicant

respectfully disagrees. Claim 57 is allowable at least for reasons discussed with respect to claim 18 and 27 as well as for its own recited features.

For reasons that are similar to those discussed above with regard to claims 18 and 27, Smith fails to disclose *"prevent* the video game application from accessing portions of the first region and the second region that are associated with other applications" as in claim 57. Furthermore, as discussed above with regards to claim 18, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98. Accordingly, for at least the reasons discussed above claim 57 is allowable.

Claims 58 and 60 depend from claim 57 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 57, are neither disclosed nor suggested in the references cited and applied by the Office.

Claim 69 recites a game console comprising:
- an input port for receiving input from a controller operable by a player to generate video game control signals;
- an output port for outputting a display of three-dimensional video game play graphics for a television;
- a processor for executing instructions of a video game program;
- a controller system coupled to said input port and to said processor for executing commands related to the video game control signals;
- a portable media reader for optically reading media to be executed by the processor so as to output to the output port a display of graphics in accordance with the media; and
- a fixed disk in a non-removable hard disk drive in communication with the processor, the fixed disk including a boot sector for storing boot instructions to boot the processor to load an initial program, wherein:
  - o upon booting the processor to load the initial program, the execution of the initial program by the processor outputs to

the output port a display of a user interface that provides a prompt for selecting media to execute on the game console, wherein *the processor will not boot without initially loading the initial program read from the fixed disk*; and

o   processor executes instructions that are read from the selected media by the portable media reader.

In making out the rejection of this claim, the Office argues that its subject matter is obvious over Smith in view of Microsoft® Windows98. Applicant respectfully disagrees. Claim 69 is allowable at least for reasons discussed with respect to claim 18 as well as for its own recited features.

For instance, the Smith reference fails to disclose a game console in which "the processor will not boot without initially loading the initial program read from the fixed disk" as recited in this claim. Although Smith discloses a hard disk drive with applications stored thereon, Smith does not disclose that the processor will not boot without initially loading the initial program read from the fixed disk, in the manner recited in this claim. In contrast, Smith instructs as follows:

> …if a game cartridge 54 is inserted into the console 52, the system will start under control of the program resident in cartridge 54. Otherwise, it will start under control of a program resident on the hard disk drive embodied in expansion device 95 as described below. *Col. 3, lines 51-56.*

Thus, Smith discloses a system in which the system will start under control of a program resident in cartridge 54 <u>or</u> under control of a program resident on the hard disk drive. Therefore, Smith does <u>not</u> require that a hard disk drive be present to boot the system because Smith can start under control of a program

resident in a cartridge. In point of fact, this teaches directly away from the recited subject matter.

Furthermore, as discussed above with regards to claim 18, the Office has failed to make out a *prima facie* case of obviousness for combining Smith with Microsoft® Windows98. Thus, for at least these reasons, Applicant respectfully submits that claim 69 is allowable.

Claims 70-71 depend from claim 69 and are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features which, in combination with those recited in claim 69, are neither disclosed nor suggested in the references cited and applied by the Office.

Claims 18, 20-35, 57-58, 60 and 69-71 are allowable for at least the foregoing reasons and it is respectfully requested that the First Ground of Rejection be overturned.

2.   **SECOND GROUND OF REJECTION**

The arguments made with respect to claim 18 and claim 27 are also applicable to claims 26 and 32-33 which each depend from claim 27.   Links 386CD Players Manual is cited for the use of nicknames (*Office Action dated 11/16/2005, p.7-8*) and does not correct the above noted defects in the combination of Smith and Microsoft®Windows98.

Accordingly, claims 26 and 32-33 which depend from claim 27 are allowable as depending from an allowable base claim.   These claims are also allowable for their own recited features which, in combination with those recited in claim 27, are neither disclosed nor suggested in the references cited and applied by the Office. For at least the foregoing reasons, claims 26 and 32-33 are allowable and it is respectfully requested that the Second Ground of Rejection be overturned.

Conclusion

The Applicant respectfully considers this application to be in condition for allowance and respectfully requests that the Board overturn the final rejection and that the Examiner pass this application to allowance

Respectfully submitted,

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CLAIMS APPENDIX

1. – 17. (Canceled)

18.   A game console comprising a processor and a hard disk drive coupled to the processor, wherein the hard disk drive stores a console application to which the game console boots, and wherein the hard disk drive is configured to store application data such that data associated with a first application is inaccessible to other applications.

19. (Canceled.)

20.   A game console as recited in claim 18 wherein the hard disk drive is further configured to store saved game data such that saved game data associated with a particular game is stored separately from saved game data associated with other games.

21.   A game console as recited in claim 18 wherein the hard disk drive is further configured to store saved game data in a user data region and configured to store application-related data in an application data region.

22.   A video game system, comprising:

a processor; and

a hard disk drive coupled to the processor, the hard disk drive having:

a first region to store user data that includes game data saved by a user of the video game system when the processor executes a video game;

and a second region to store application data that includes data specific to the video game executed by the processor, wherein user data associated with the video game is segregated from user data associated with other video game applications and wherein the application data associated with the video game is segregated from application data associated with other video game applications.

23.   A video game system as recited in claim 22 wherein the user data includes saved game data.

24.   A video game system as recited in claim 22 wherein the application data includes data to be used during future executions of the associated application.

25.   A video game system as recited in claim 22 further including a console application stored on the hard disk drive, the console application being configured to generate a list of user data stored in the first region.

26.   A video game system as recited in claim 22 wherein the disk drive is configured to store a list of recently used nicknames.

27.   A method comprising:

identifying a game identifier associated with a video game installed in a game console, wherein the game console contains a hard disk drive;

determining portions of the hard disk drive that are associated with the video game based on the game identifier; and

preventing the video game from accessing portions of the hard disk drive that are not associated with the video game.

28.   A method as recited in claim 27 further including saving a current state of the video game to the hard disk drive in response to a save game request.

29.   A method as recited in claim 27 further including retrieving a list of saved games associated with the video game installed in the game console.

30.   A method as recited in claim 27 further including:

retrieving a list of saved games associated with the video game installed in the game console; and

displaying the list of saved games to a user of the game console.

31.   A method as recited in claim 27 further including:

retrieving a list of saved games associated with the video game installed in the game console;

displaying the list of saved games to a user of the game console; and

executing the video game using saved game data selected by the user of the game console.

32. A method as recited in claim 27 further including retrieving a list of recently used nicknames.

33. A method as recited in claim 27 further including retrieving a list of recently used nicknames associated with the video game installed in the game console.

34. A method as recited in claim 27 wherein determining portions of the hard disk drive that are associated with the video game based on the game identifier comprises:

determining a portion of a user data region on the hard disk drive that is associated with the video game that includes game data saved by a user of the game console when executing a video game; and

determining a portion of an application data region on the hard disk drive that is associated with the video game and that includes data specific to the video game installed in the game console.

35. One or more computer-readable media comprising computer-executable instructions that, when executed, perform the method as recited in claim 27.

36. – 56. (Canceled)

57.   A computer-readable medium for a game console comprising computer-executable instructions that, when executed, direct the game console to:

associate user data with a first region of a hard disk drive contained in the game console;

associate video game application data with a second region of the hard disk drive;

allow a video game application to access particular portions of the first region that are associated with the video game application;

allow the video game application to access particular portions of the second region that are associated with the video game application; and

prevent the video game application from accessing portions of the first region and the second region that are associated with other applications.

58.   A computer-readable medium as recited in claim 57 wherein the computer-executable instructions further direct the game console to allow the video game application to access data in a portable memory unit coupled to a controller, wherein the controller is coupled to the game console.

59. Canceled.

60.   A computer-readable medium as recited in claim 57 wherein the video game application receives user input from a controller coupled to the game console.

61. - 68. (Canceled)

69.   A game console comprising:

an input port for receiving input from a controller operable by a player to generate video game control signals;

an output port for outputting a display of three-dimensional video game play graphics for a television;

a processor for executing instructions of a video game program;

a controller system coupled to said input port and to said processor for executing commands related to the video game control signals;

a portable media reader for optically reading media to be executed by the processor so as to output to the output port a display of graphics in accordance with the media; and

a fixed disk in a non-removable hard disk drive in communication with the processor, the fixed disk including a boot sector for storing boot instructions to boot the processor to load an initial program, wherein:

upon booting the processor to load the initial program, the execution of the initial program by the processor outputs to the output port a display of a user interface that provides a prompt for selecting media to execute on the game console, wherein the processor will not boot without initially loading the initial program read from the fixed disk; and

processor executes instructions that are read from the selected media by the portable media reader.

70.   The video game system console as defined in Claim 69, wherein the initial program is initially loaded from the hard disk drive upon booting the processor such that, prior to the portable media reader reading media containing video game instructions, a display containing the prompt is output to the output port.

71.   The method as defined in Claim 69, further comprising:

identifying an identifier associated with the media;

determining portions of the hard disk drive that are associated with the identifier; and

preventing access to portions of the hard disk drive that are not associated with the identifier.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.